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| <b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>  |   | <b>Docket Number (Optional)</b><br><b>3670-45</b> |
|---|---|---|
|    | Application Number<br><b>10/092,535</b> | Filed<br><b>March 8, 2002</b>                     |
|   | First Named Inventor<br><b>STILLE</b>   |   |
|   | Art Unit<br><b>2684</b>                 | Examiner<br><b>Aminzay, Shaima Q.</b>             |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).<br/>Note: No more than five (5) pages may be provided.</p>  |   |   |
| <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p>I am the</p> <p><input type="checkbox"/> Applicant/Inventor</p> <p><input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> Attorney or agent of record <u>33,149</u><br/>(Reg. No.)</p> <p><input type="checkbox"/> Attorney or agent acting under 37CFR 1.34.<br/>Registration number if acting under 37 C.F.R. § 1.34 _____</p> </div> <div style="width: 50%; text-align: center;"> <br/>           _____<br/>           Signature<br/><br/> <b>John R. Lastova</b><br/><br/>           _____<br/>           Typed or printed name<br/><br/>           _____<br/> <b>703-816-4025</b><br/>           Requester's telephone number<br/><br/>           _____<br/> <b>September 5, 2006</b><br/>           Date         </div> </div> |   |   |
| <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p> <p><input checked="" type="checkbox"/> *Total of <b>1</b> form/s are submitted.</p>   |   |   |

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

STILLE et al.

Atty. Ref.: 3670-45; Confirmation No. 8875

Appl. No. 10/092,535

TC/A.U. 2684

Filed: March 8, 2002

Examiner: Aminzay, Shaima Q.

For: METHOD AND DEVICE FOR A SHARED RADIO NETWORK

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September 5, 2006

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**STATEMENT OF ARGUMENTS IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In response to the final office action dated June 16, 2006, Applicants file this pre-appeal request. An interview was conducted with the Examiner on January 4, 2006 during which the undersigned explained the deficiencies of the pending rejection. The Examiner was not persuaded to withdraw the rejection.

**Clear Error #1: Neither Purnadi Nor Lintulampi Teach Multiple Owners Of The Same  
Network**

The Examiner rejects all claims as being unpatentable over U.S. Patent 6,708,031 to Purnadi in view of U.S. Patent 6,377,804 to Lintulampi. Purnadi describes a handoff procedure where the mobile terminal may visit another network other than its home network. Purnadi wants subscribers to be able to roam between cellular networks and preferably access the same

services available in the home network when they are visiting other networks. Purnadi fails to disclose any teaching that *one network is shared by multiple owners*.

Purnardi and Lintulampi both describe visited networks in the context of roaming and handover. The Examiner apparently equates a mobile "visiting" a network other than its "home" network with shared ownership of a network. But they are not the same. Nor would a person of ordinary skill in cellular communications confuse these two very different concepts.<sup>1</sup>

A visited network is visited from the mobile's perspective. A mobile has a home network to which it subscribes. In Purnadi, that home network is owned by a home network operator. When the mobile roams into another service area outside the service area of its home network, the mobile may obtain service as a roaming mobile from a visiting network, assuming the mobile's subscription permits the mobile to be serviced in that visiting network. But the home network operator does not own the visited network. Nor does the visited network operator have an ownership in the home network. The fact that the home network and the visited network have a roaming agreement that allows certain of the home network mobile's to receive roaming service from the visited network has no bearing on the ownership of those networks.

Lintulampi is similar to Purnadi where a mobile subscribes to a 2G network and visits a 3G network when services required the user are not accessible at the 2G network. Each network in Lintulampi has its respective different owner. See for example col. 4, lines 13-16 where Lintulampi defines the "GSM operator, owner of the first network" and "UMTS operator, owner of the second network."

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<sup>1</sup> Figure 2 illustrates an example of a network shared by multiple operators/owners. It is plain from this figure that a shared network ownership is different than roaming arrangements between network operators.

The Examiner seems to be arguing that the visited network is sharing its network with the visiting mobile terminal or with the home network operator. But a roaming agreement between two networks (the Examiner's argued sharing arrangement) is not all that is claimed. The independent claims specifically recite "determining which one of the *owners* of a *shared radio network* that a visiting MT (Mobile Terminal), which MT is not subscribed to any of the owners of said shared radio network, is going to be connected to." Neither reference teaches a shared radio network having multiple owners. As a result, the decision as to which owner the mobile will be connected to that is required by the pending claims is not made in either Purnadi or Chow.

The Examiner never acknowledges this distinction between a visited network owned by one operator and a shared network serving a visiting mobile terminal that is owned by multiple operators. To highlight this difference, consider the example of a shared 3G network in the instant specification. 3G radio networks are expensive. One way to decrease the costs is for two or more 3G operators to jointly buy a shared 3G radio network like a UTRAN. But nothing in Purnadi discloses or suggests that the UTRAN 103 is shared by two or more network operators.

Neither Purnadi nor Lintulampi teach that any one of the networks has two or more owners. Only different networks with separate owners are described.

**Clear Error #2: Neither Purnadi Nor Lintulampi Teach Determining Which Owner The Mobile Terminal Is Going To Be Connected To**

The Examiner admits that Purnadi does not disclose "determining *which one of said owners* said visiting MT is going to be connected based on the derived information," and relies on Lintulampi. As explained above, Lintulampi fails to disclose that the visited network is

*shared by different owners*. Again, the 2G network is owned by one operator, and the 3G network is owned by another owner. E.g., col. 4, lines 13-16. In the independent claims, it is not simply a matter of determining whether a mobile terminal is permitted to roam to a particular visiting network. Rather, the independent claims acknowledge that an *additional decision* is needed when a network is shared by two or more *owners*. Namely, it must be determined which one of the owners of the shared network that a visiting mobile terminal, which is not a subscriber with any of the owners of the shared radio network, is going to be connected to. Since neither Purnadi nor Lintulampi teach this additional feature, their combination also fails to disclose the features related to shared network owners.

**Clear Error #3: There Is No Proper Motivation To Combine Purnadi and Lintulampi**

The combination of Purnadi and Lintulampi is based on improper hindsight. To prevent the use of improper hindsight, the Federal Circuit requires the Examiner to show a motivation to combine the references. Specifically, the Federal Circuit has stated:

the Examiner must show reasons that the skilled artisan, confronted with **the same problems as the inventor** and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

*In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Neither Purnadi nor Lintulampi acknowledge that a network owned by multiple network operators even exists, let alone the problems that confront the multiple owners/operators of such shared networks when a visiting mobile terminal, which is not a subscriber with any of the owners of the shared network, requires service from the shared network. The Examiner never addresses this deficiency, notwithstanding the Federal Circuit's mandate above. Unlike Purnadi

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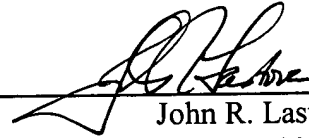
or Lintulampi, the claimed invention solves these problems by deriving information from the visiting mobile terminal and using this information to determine which one of the owners of the shared network that the visiting mobile terminal is going to be connected to.

Lacking the combination of features recited in the independent claim and a proper motivation to combine the references, Applicants respectfully submit that the rejection should be withdrawn and this application allowed.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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